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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,584	02/12/2002	David Lawrence	G08.018	8233
27383	7590	11/10/2004	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,584

Applicant(s)LAWRENCE, DAVID **Examiner**

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/30/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on August 23, 2004. Applicant's election of claims 1-23 and 25-33 without traverse in response to restriction/election requirements and cancellation of claims 34-36 have been entered. Claims 1-23 and 25-33 are currently pending. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23 and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al (US Patent 6,119,103) in view of Irving et al (US Patent 5,991,743).

With reference to claim 1, Basch teaches a computer-implemented method for managing risk, the method comprising: gathering in a computer device relevant data from multiple sources (See Basch Column 1 lines 21-35, 48-51, and Column 5 lines 14-16, 31-45); and receiving an inquiry relating to a risk subject related to at least one of: the entity and the activity; (See Basch Figure 1, Column 5 line 8 – Column 6 line 8, and Claims 1, 21, 26). Communication network and a transmission medium are inherent in the invention of Basch. Relevant data includes data relevant to regulation of an entity engaged in an activity described in Section 4(k)(4) of the Bank Holding Act of 1956 for instance data about fraudulent transactions (See Basch Column 1 lines 21-35, 48-51, and Column 5 lines 14-16, 31-45).

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Basch does teach the steps of aggregating the data gathered according to risk variables relevant to potential violations of at least one of: laws, regulations and industry rules; associating portions of the aggregated data with the risk subject; and transmitting to a designated party the associated portions of the aggregated data.

Irving teaches the steps of aggregating the data gathered according to risk variables relevant to potential violations of at least one of: laws, regulations and industry rules (See Irving Column 3 lines 33-37, legislation by government includes regulations and laws); associating portions of the aggregated data with the risk subject (See Irving Figure 2, Abstract, Column 2 lines 40-41, Column 3 lines 4-37 and Claim 1); and transmitting to a designated party the associated portions of the aggregated data (See Irving Column 7 lines 25-28 and Claim 1). Sending a report to the risk manager includes the step of transmitting the associated portions of the aggregated data to a designated party.

Both Basch and Irving are concerned with predicting and managing risk exposure for identified risk subjects. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosure of Irving to the invention of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the client proactively monitor and manage the risk associated with the risk subject after an initial decision has been made.

With reference to claim 2, Irving teaches the step wherein the gathered data is gathered exclusively from publicly available sources (See Irving Col 3 lines 16-20)

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With reference to claims 3-6, Irving teaches communication involving system-to-system batch requests (See Irving Col 3 lines 51-57) and communications received electronically, via facsimile, and via voice communication (See Irving Col 2 lines 44-45).

With reference to claims 9, 14, 23 and 25-33 Irving teaches the steps wherein the gathered data does relates to commercial entities (See Irving Col 3 lines 6-10); wherein the gathered data related relevant to regulation accurately reports on or consists of a governmental record (See Irving Col 3 lines 16-20, lines 33-37); continually monitoring the aggregated data and transmitting any new information related the risk subject (See Irving Col 3 lines 51-57); enhancing the gathered data including data descriptive of the risk subject and scrubbing the data to incorporate new information (See Irving Col 6 line 66- Col 7 line 10); augmenting the associated portions of aggregated data (See Irving Col 6 lines 9-17); associating portions of aggregated data comprises relevance ranking (See Irving Col 5 lines 51-55); and receiving a source of gathered data and transmitting the source of the associated portions of aggregated data (See Irving Col 6 lines 9-17). Enhancing data is interpreted to include using index files and augmenting aggregate data is interpreted to include using data mining and Boolean logic. Alternatively these steps are old and well known in the art. These steps make the process of enhancing or augmenting data more efficient.

With reference to claims 7, 8, 10-12 and 20-22, Basch teaches the steps wherein transmitting the associated portions of the aggregated data to institutions by transmitters covered by Gramm-Leach-Bliley Act is conditioned upon receipt of a contractual obligation to limit use of the aggregated data for complying with regulatory and legal obligations associated with fraud and the prevention or detection of a crime (See Basch Col 5 lines 35-45) and wherein the risk

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subject comprises details descriptive of a financial transaction, parties involved in a financial transaction, and wherein the inquiry relating to a risk subject comprises an alert list (See Basch Figure 1). The step of transmitting data to recipients conditioned upon receipt of a contractual obligation to limit use in compliance with regulatory and legal obligations is implied in the disclosure of Basch. Such receipts protect the transmitter from legal problems if the recipient misuses the information.

With reference to claims 13 and 15-19, Basch and Irving combined do not explicitly teach the steps wherein the gathered data relevant to regulation does not include information sourced from a credit report; insuring that the source of gathered data relevant to regulation is reputable; wherein none of the associated portions of the aggregated data transmitted comprises any content created or developed by a provider of the computer-implemented method for managing risk associated with government regulation or none of the aggregated data comprises any consumer reporting data; and the step of generating a report relates to a financial institution's obligation to know their customer or a financial institution's obligation to file Suspicious Activity Reports.

Official notice is taken that these steps are old and well known in the art. These steps help ensure that only relevant data is collected from properly selected sources and that the laws and regulations are followed by all the parties to the transaction.

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the combined disclosures of Irving and Basch. The combination of the disclosures taken as a whole suggests that it would have helped all parties using the system

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ensure that only relevant data is collected from properly selected sources and that the laws and regulations are followed by all the parties to the transaction.

Response to Arguments

4. With respect to Applicant's assertion on page 12 of the amendment dated April 22, 2004 that "Basch, however, in no way teaches or suggests any methods or systems related to the identification and evaluation of risks associated with government regulation of financial transactions", the Examiner disagrees. Basch teaches methods or systems related to the identification and evaluation of fraud, which is one of the risks associated with government regulation of financial transactions (See Basch Column 1 lines 21-35, 48-51, and Column 5 lines 14-16, 31-45).

Applicant's other arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

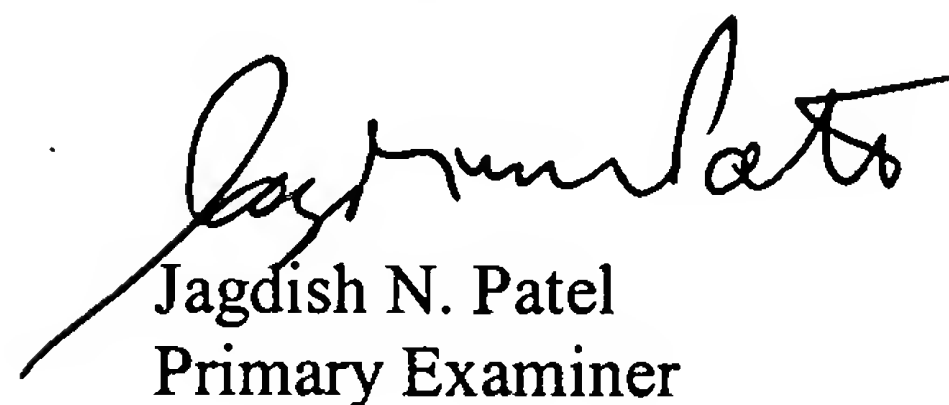
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
November 5, 2004

 11/5/04
Jagdish N. Patel
Primary Examiner